REMARKS/ARGUMENTS

In response to the above identified Office Action, Applicant has amended the application and respectfully requests reconsideration thereof.

Amendment of Claims

Claims 21 and 53 have been amended to include subject matter that places the claim within the technological arts, establishes a statutory class for the invention, and sets forth a useful, concrete and tangible result. Specifically, claims 21 and 53 are amended to require a system that stores information in a database and retrieves the information from the database. Support for these amendments may be found throughout the specification.

Claims 22–32 and 55 have been amended in response to and consistent with the amendments of claim 21 and 53, respectively.

Claim 42 has been amended in response to and consistent with the Examiner's suggestion.

Claims 1 and 46 have been amended to include the limitations of claims 8 and 9.

Claim 21 has been amended to include the limitation of claim 23.

Claim 38 has been amended to include one of the limitations of claim 42.

Claims 8, 9 and 23 have been cancelled.

Claim 50 has been amended to include the limitation of claim 23.

Response to Claim Rejections – 35 USC § 101

Claims 21-32, 42, and 55-56 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Applicant respectfully submits that claims 21-32, 42, and 55-56 should not be rejected under 35 U.S.C. § 101 for the reason that claims 21-32, 42, and 55-56, as amended, are directed towards statutory subject matter.

Claim 21, as amended, includes the following limitations:

> A system to store information in a database and to retrieve the information from the database, the system comprising:
>
> a first code corresponding to one aspect of a patient's health;
>
> a list of one or more definitions corresponding to the first code; and
>
> a first list of data sources obtained based upon the one or more definitions, wherein the first code, the list of one or more definitions and the first list of data sources are utilized to store information in the database and to retrieve information from the database; ...

Claim 21, as amended, requires a system that operates within the technological art of storing and retrieving information. Moreover, the recited system includes a database that utilizes components in the form of code, a list and a first list to store and retrieve information. Thus, the database imparts functionality to the components by facilitating storage and retrieval. Further, claim 1, as amended, characterizes an

invention that produces a useful, concrete, and tangible result by providing access to information otherwise inaccessible thereby achieving an effect that is both real and actual. Finally, claim 21, as amended, explicitly identifies the statutory class of the invention as a "system".

Independent claim 55 includes a limitation corresponding substantially to the above-discussed limitation of claim 21. Accordingly, Applicant requests that the above remarks and amendments contained herein also be considered when examining claim 55 for allow ability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 22-32 and 56 under 35 U.S.C. 101 is also addressed by the above remarks, and the amendments contained herein.

Claim 42, as amended, includes the following limitations:

> The system of claim 38, wherein the first server includes a machine-readable medium comprising instructions which, when executed by a machine, cause the machine to perform operations, the instructions to comprise: ...

Thus, claim 42, as amended, includes limitations that are similar to those suggested by the examiner.

In summary Applicant respectfully submits that claims 21-32, 42, and 55-56 should not be rejected under 35 U.S.C. § 101 for the reason that claims 21-32, 42, and 55-56, as amended, are directed towards statutory subject matter.

Response to Claim Rejections – 35 USC § 103

Claims 1-37 and 46-54 stand rejected under 35 U.S.C. § 103, as being allegedly unpatentable over Kirk et al (US Patent No. 5,768,578; hereinafter Kirk) in view of Evans (US Patent No. 5,924,074; hereinafter Evans).

Applicant respectfully submits that claims 1-37 and 46-54 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

> To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 includes the following limitation:

> "generating the set of queries comprises: selecting a set of existing queries that correspond to the received information about the patient."

The Office Action, in rejecting claim 1, contends that the above limitation is anticipated by the following disclosure in Kirk:

> When a user wishes to obtain information, the user inputs a query in system 101's query language at graphical user interface 103. System 101 then answers the query. There are several steps involved. First, query translator 107 translates the query into a form to which knowledge representation system 109 can respond. Then the translated query is analyzed in knowledge base system 109 to decide which of the external information sources are relevant to the query, and which subqueries need to be sent to each information source.

Kirk, Col. 5, lines 39-47.

The above quote from Kirk describes a user inputting a query that is processed by a query translator 107. The query translator translates the query into a form to which the knowledge representation system 109 can respond.

Claim 1 requires selecting a set of existing queries that correspond to the received information about the patient. For example, a set of queries may be generated in response to receiving information about a patient. This same set of existing queries is then selected in response to performing a query function. In contrast, Kirk does not disclose selecting a set of existing queries that correspond to the received information about the patient; but rather, merely translating the query into a form to which the knowledge representation system can respond. Kirk therefore cannot be said to anticipate the above quoted limitation because Kirk discloses translating the query into a form to which the knowledge representation system can respond and claim 1 requires selecting a set of existing queries that correspond to the received information about the patient.

Independent claims 21, 33, 46 and 50 each include a limitation corresponding substantially to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these independent claims.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-19, 22-32 34-37 47-49 and 51-54 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Kirk in combination with Evans does not teach or suggest each and every limitation of claims 1-37 and 46-54 as required to support rejections of the independent claims of the present application under 35 U.S.C.§ 103.

Claims 38-45 stand rejected under 35 U.S.C. § 103, as being allegedly unpatentable over Evans in view of the knowledge of one having ordinary skill in the art.

Independent claim 38, as amended, includes a limitation corresponding substantially to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these independent claims.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending there from is nonobvious and rejection of claims 39-45 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Evans in combination with the knowledge of one having ordinary skill in the art does not teach or suggest each and every limitation of claims 38-45 as

required to support rejections of the independent claims of the present application under 35 U.S.C.§ 103.

Claims 55-56 stand rejected under 35 U.S.C. § 103, as being allegedly unpatentable over Evans in view of Rozen et al (US Patent No. 6,073,106; hereinafter Rozen)

Independent claim 55, as amended, includes a limitation corresponding substantially to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these independent claims.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending there from is nonobvious and rejection of claims 56 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Evans in combination with Rozen does not teach or suggest each and every limitation of claims 38-45 as required to support rejections of the independent claims of the present application under 35 U.S.C.§ 103.

In summary, Applicant believes that all rejections presented in the Office Action have been fully addressed and withdrawal of these rejections is respectfully requested. Applicant furthermore believes that all claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Mark Vatuone at (408) 947-8200.

Respectfully submitted,

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